

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPEAL BRIEF**

**Application No.: 09/112131**

**Customer No.: 22927**

**Attorney Docket No.:** 96-002-C1

**Date Filed:** July 8, 1998

**Title:** METHOD AND APPARATUS FOR A  
CRYPTOGRAPHICALLY ASSISTED COMMERCIAL  
NETWORK SYSTEM DESIGNED TO FACILITATE  
AND SUPPORT EXPERT-BASED COMMERCE

**Applicants:** Walker et al.

**Group Art Unit:** 3661

**Examiner:** NGUYEN, Cuong H.  
(571) 272-6759 /voice  
(571) 273-8300 /fax

**BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this Appeal Brief following the Examiner's Office Action  
mailed August 25, 2005 (Paper No. / Mail Date 061105).

## TABLE OF CONTENTS

REAL PARTY IN INTEREST.....	4
RELATED APPEALS AND INTERFERENCES .....	5
STATUS OF CLAIMS.....	6
STATUS OF AMENDMENTS.....	7
SUMMARY OF CLAIMED SUBJECT MATTER.....	8
1.    Independent Claim 177 .....	9
2.    Independent Claim 178 .....	9
3.    Independent Claim 179 .....	10
4.    Independent Claim 185 .....	11
GROUNDSC OF REJECTION TO BE REVIEWED ON APPEAL.....	12
1.    Section 102(b)—MPEP Section 705.01(e) and Section 1005 ....	12
2.    Section 103(a)—MPEP Section 705.01(e), Section 1005, and	
Section 1002.02.....	12
3.    Section 103(a)—MPEP Section 705.01(e), Section 1005, and	
Section 1002.02 + Unsupported Assertions.....	13
ARGUMENT.....	14
1.    Summary of Arguments .....	14
2.    Form of Appeal Brief .....	16
3.    Section 102(b)— MPEP Section 705.01(e) and MPEP Section	
1005 .....	17
4.    Section 103(a)—MPEP Section 705.01(e), Section 1005, and	
Section 1002.02.....	34
5.    Section 103(a)—MPEP Section 705.01(e), Section 1005, Section	
1002.02 and Unsupported Assertions .....	46
CONCLUSION.....	57
APPENDIX A—CLAIMS INVOLVED IN THE APPEAL .....	58

APPENDIX B—EVIDENCE <NONE> .....	62
APPENDIX C—RELATED PROCEEDINGS <NONE> .....	63

**REAL PARTY IN INTEREST**

The present application is assigned to Walker Digital, LLC, 2 High Ridge Park, Stamford, CT 06905.

## **RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' legal representative and Appellants' assignee know of no interferences or appeals that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

## **STATUS OF CLAIMS**

Claims 177-189 are pending, rejected, and are being appealed.

Claims 1-176 and 190-195 are cancelled.

**STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the Office Action mailed  
August 25, 2005.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

Claims 177, 178, 179, and 185 are independent.

Concise explanations of the independent claims are provided below. As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification. Any such reference and / or accompanying explanation:

(i) is by way of example of the claimed subject matter only and is not a comprehensive description of the scope of the independent claim being discussed, nor a comprehensive listing of support in the specification for the independent claim being discussed;

(ii) might be potentially useful in clarifying the particular subject matter of the particular independent claim being discussed (and not other claims or “the invention” as a whole), unless explicitly stated otherwise; and

(iii) is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, unless explicitly stated otherwise.

Additionally, any explanation or reference to the specification which refers to more than one claim, or is utilized in the explanation of more than one claim, is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, and is not to be considered as indicating any equivalence of any claims or parts of a claim.

Generally, an embodiment of the invention allows an expert seeking to sell his services to more efficiently find a client, and furthermore allows the client to certify and authenticate the expert's qualifications. The client can hire the expert. If desired by either party, payment can be guaranteed to the expert for the expert services to be provided, while also guaranteeing the buyer's satisfaction with the expert service. See, e.g., Specification, "Summary of the Invention", page 13, lines 9 – 15.

Generally, according to an embodiment of the invention, a quality monitoring feature is provided. If the user is dissatisfied with a response, the request is forwarded to another qualified expert for review. This peer review either accepts or rejects the response, and appropriate action may be taken. See, e.g., Specification, "Summary of the Invention", page 21, lines 8 - 11.

## **1. Independent Claim 177**

Independent Claim 177 is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert. A second expert that has a second expert qualification is selected. The second expert qualification is higher than the first expert qualification. The first expert qualification is transmitted to the second expert. A signal is received from the second expert. This signal indicates approval of the first expert qualification. For some examples, see Specification, page 16, lines 6 – 13; page 38, lines 1 – 12; FIG. 2 (200); and accompanying text.

## **2. Independent Claim 178**

The method of independent Claim 178 includes the method of independent Claim 177, and also includes incorporating identity data of the second expert into a

key of the first expert. See, e.g., Specification, page 38, lines 7-9; FIG. 2 (200); and accompanying text.

**3. Independent Claim 179**

Independent Claim 179 is directed to a computer implemented expert matching method for managing communications between an expert and an end user. A first expert qualification is received. This first expert qualification corresponds to a first expert. The first expert qualification is submitted for review by a set of experts that each has a qualification that is higher than the first expert qualification. A signal is received from the set of experts. This signal indicates approval of the first expert qualification. For some examples, see Specification, page 16, lines 6 – 13; page 38, lines 1 – 12; FIG. 2 (200); and accompanying text.

The method also includes receiving an end user request from an end user. For some examples, see Specification, page 35, line 14 to page 40, line 7; FIG. 2 (200); FIG. 6 (650); FIG. 7 (700); and accompanying text. The method also includes selecting the first expert based on the end user request. For some examples, see Specification, page 42, line 1 to page 44, line 11; FIG. 2 (200); FIG. 7 (710, 720, 760, 770); and accompanying text.

The method also includes transmitting at least a portion of the end user request to the first expert. For some examples, see Specification, page 44, line 12 to page 45, line 7; FIG. 2 (200); FIG. 8 (810, 860); and accompanying text.

The method also includes receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert, and transmitting the expert answer to the end user. For some examples, see Specification, page 45, lines 8 – 16; FIG. 2 (200); FIG. 9 (920, 940); FIG. 10 (1000); and accompanying text.

**4. Independent Claim 185**

The method of independent Claim 185 includes the method of independent Claim 177, discussed above. Claim 185 also includes steps of receiving an end user, selecting the first expert, transmitting at least a portion of the end user request to the first expert, receiving the expert answer containing information about the second expert, and transmitting the expert answer to the end user. These steps are discussed above with respect to Claim 179.

## **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

### **1. Section 102(b)—MPEP Section 705.01(e) and Section 1005**

Claim 177 stands rejected under 35 U.S.C. § 102(b) as being anticipated by: Manual of Patent Examining Procedure, Revision 14, Section 705.01(e), p. 700-5 (Nov. 1992) (“MPEP Section 705.01(e)”) and Section 1005, p. 1000-9 (“MPEP Section 1005”).

### **2. Section 103(a)—MPEP Section 705.01(e), Section 1005, and Section 1002.02**

Claim 178 stands rejected under 35 U.S.C. § 103(a) as being obvious in light of findings allegedly supported by the following :

MPEP Section 705.01(e);  
MPEP Section 1005; and  
Manual of Patent Examining Procedure, Revision 14, Section 1002.02, p. 1000-3 (“MPEP Section 1002.02”).

3. **Section 103(a)—MPEP Section 705.01(e), Section 1005, and Section 1002.02 + Unsupported Assertions**

Claims 179-189 stand rejected under 35 U.S.C. § 103(a) as being obvious in light of findings allegedly supported by the following :

MPEP Section 705.01(e);

MPEP Section 1005;

MPEP Section 1002.02; and

asserted subject matter that the Examiner does not even indicate any evidence of record could support.

## **ARGUMENT**

### **1. Summary of Arguments**

All of the rejections are inappropriate and Appellants respectfully request that the rejections be reversed.

#### **1.1. Section 102(b) Rejection: Claim 177**

The Examiner has failed to establish that the cited evidence (MPEP Section 705.01(e) and MPEP Section 1005) teaches (explicitly or implicitly) all of the claimed subject matter of Claim 177. The Examiner has failed to establish by substantial evidence of record a prima facie case of anticipation for Claim 177, and the Section 102(b) rejections must be reversed.

#### **1.2. Section 103(a) Rejections: Claims 178-189**

The Examiner has not made any prima facie case of obviousness, and in any event no evidence is of record that could support a showing of obviousness for any of Claims 178-189.

Even if the cited evidence (MPEP Section 705.01(e), MPEP Section 1005 and MPEP Section 1002.02) supported the Examiner's assertions as to what subject matter was known, the record lacks evidence of any teaching, suggestion, or motivation to modify to make the proposed modifications of that subject matter to produce any of the specific combinations of features for any claim. With respect to Claims 179-189, the Examiner does not even indicate any evidence of record could support the Examiner's assertions that some of the specific claim limitations were known.

Also, even if evidence of record supported the Examiner's purported motivation to modify or combine the references in the manner suggested, the resulting combination would fail to teach or suggest all of the specific features of any claim. The Section 103(a) rejections must be reversed.

**2. Form of Appeal Brief**

In the arguments herein, limitations of the claims are indicated in *italics* and the references of record are indicated by underlining.

In separate arguments of patentability for separate claims (or groups of claims), Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants refer to:

- Office Action: Non-Final Office Action mailed August 25, 2005
- First Appeal Brief: Appeal Brief filed September 23, 2003

### **3. Section 102(b)—MPEP Section 705.01(e) and MPEP Section 1005**

Appealed Claim 177 stands rejected under 35 U.S.C. § 102(b) as being anticipated by MPEP Section 705.01(e) and MPEP Section 1005.

#### **3.1. Introduction**

Claim 177 is independent.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no prima facie case of anticipation exists.

The rejection of Claim 177 is flawed because the Examiner has not made a prima facie case of anticipation and the Examiner has otherwise failed to establish by substantial evidence that the particular method of Claim 177 was known at the time of Appellants' invention.

The embodiment of claim 177 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record. These advantages render the claimed subject matter nonobvious over the cited art.

As discussed in the present application, by *selecting a second expert that has a second expert qualification which is higher than the first expert qualification (of a first expert)*, a higher level expert may be located.

By *transmitting the first expert qualification to the second expert*, the second expert is in a position to evaluate the qualifications of the first (lower level) expert.

By *receiving a signal from the second expert that indicates approval of the first expert qualification*, one can receive the approval of the first expert by the second expert.

Thus, the method recited in claim 177 may be used, when evaluating an expert, to find a higher-level expert and then receive from that higher-level expert an indication of whether the first expert is approved. Such a method is extremely

useful in, e.g., allowing experts to sell their services to clients that do not know them, allowing clients to trust experts selling services, and generally facilitate commerce in expert advice and services.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

### **3.2. Applicable Law**

#### **3.2.1. Prima facie burden**

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992).

#### **3.2.2. Substantial evidence required for all factual findings**

The Board is not permitted to accept conclusory, unsupported findings made by the Primary Examiner that are not supported by substantial evidence made of record.

All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. *In re Gartside*, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described "substantial evidence" in the following manner:

substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); see also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 1935, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (“Zurko III”).

“[R]eview under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency’s decision.” Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162.

### **3.2.3. Anticipation**

Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference.

Minnesota Min. & Mfg. Co., v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559, 24 U.S.P.Q.2D 1321 (Fed. Cir. 1992); Glaverbel S.A. v. Northlake Mkt’g & Supp., Inc., 45 F.3d 1550, 33 U.S.P.Q.2D 1496 (Fed. Cir. 1995).

There must not be any differences between the claimed invention and the prior art disclosure, as viewed by a person of ordinary skill in the art, for anticipation to exist. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 U.S.P.Q.2D 1001 (Fed. Cir. 1991). Thus, the absence of any claim element from the reference negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 160 (Fed. Cir. 1986).

Further, as explained in Motorola, Inc. v. Interdigital Tech. Corp.:

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See In re Spada, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990) (“The [prior art] reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.” (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.

121 F.3d 1461, 1473, 43 U.S.P.Q.2D 1481, 1490 (Fed. Cir. 1997).

**3.2.4. Claim interpretation must be consistent with the specification**

During examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); In re Cortright, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2D 1023, 1027 (Fed. Cir. 1997).

**3.3. No showing that MPEP Section 705.01(e) teaches selecting a second expert that has a second expert qualification which is higher than the first expert qualification (of a first expert for which a first expert qualification was received)**

The Examiner has not shown that the prior art teaches *selecting a second expert that has a second expert qualification which is higher than the first expert qualification (of a first expert for which a first expert qualification was received)*. With respect to this claimed subject matter the Examiner puts forth at least three interpretations of what was allegedly known in the prior art. The only evidence cited in support of all of the interpretations is MPEP Section 705.01(e). In fact, nothing in the cited evidence would suggest that, after a first expert qualification is received, a second expert (with a higher qualification) is selected. Accordingly, the Examiner has not provided a *prima facie* case of unpatentability of this claim.

First Interpretation of MPEP Section 705.01(e)

According to a first interpretation:

a group director/supervisor for this examiner...is also selected to review and approve that examiner's qualification/decision

[Office Action, page 3 (citing MPEP Section 705.01(e))].

Appellants understand that in this first interpretation, the first expert of the claim limitation is a patent examiner to whom a patent application has been assigned, and the second expert of the claim limitation is the group director or supervisor for that patent examiner. Appellants have reviewed MPEP Section 705.01(e) and have found no indication of a process in which a group director or supervisor is selected, much less selected to "review and approve" the qualification of a patent examiner to whom an application has already been assigned. The Examiner does not explain how any description in MPEP Section 705.01(e) could be so interpreted. In particular, MPEP Section 705.01(e) includes only a discussion of limitations of use of a "Patentability Report" practice. Nothing in MPEP Section 705.01(e) indicates that a group director or supervisor is selected.

To the contrary, the Examiner asserts that MPEP Section 705.01(e) teaches that the patent examiner is selected by the group director: "i.e. USPTO's specific group director 'assigns' an examiner to examine a patent application". [Office Action, page 3 (citing MPEP Section 705.01(e))]. Appellants note that they were unable to identify any teaching in MPEP Section 705.01(e) that would support this finding, either. Nonetheless, according to this other finding of the Examiner, the second expert selects a first expert. This situation is in fact typical of many hierarchical relationships, where those with higher skills manage and select among their subordinates with lower skills. However, it is clearly the opposite of the claim limitation in which the second expert (with a higher expert qualification) is

selected. The Examiner's example has the first expert being selected by the second expert. It would be nonsensical to argue that the second expert ("group director") somehow selects himself.

Second Interpretation of MPEP Section 705.01(e)

According to a second interpretation:

a primary examiner outside his art unit for consultation on a specific subject matter e.g., a patent application on business method using a smart-card technology; a primary examiner that specializes in another art unit dealing with smart-card technology is consulted) is also selected to review and approve that examiner's qualification/decision

[Office Action, page 3 (citing MPEP Section 705.01(e))].

Appellants' understand the Examiner is asserting that it was known to select a primary examiner, who is not in the art unit of a patent examiner assigned to the patent application, "for consultation on a specific subject matter." Appellants understand that in this second interpretation, the first expert of the claim limitation is a patent examiner to whom a patent application has been assigned, and the second expert of the claim limitation is a primary examiner. Appellants have reviewed MPEP Section 705.01(e) and have found no indication of a process in which a primary examiner is selected to "review and approve" the qualification of a patent examiner to whom an application has already been assigned.

MPEP Section 705.01(e) is silent on the relative qualifications of the "specialists" who "treat the claims directed to their specialty," so there is no basis for the Examiner's conclusion that any aspect of the Patentability Report practice discussed in MPEP Section 705.01(e) necessarily involves selecting an individual having a qualification higher than the qualification of a patent examiner to whom an application has already been assigned.

Even assuming for the sake of argument that MPEP Section 705.01(e) suggests specifically selecting a primary examiner for consultation, there is no

suggestion that such a primary examiner would “review and approve” anything related to the qualification of the assigned patent examiner. To the contrary, MPEP Section 705.01(e) indicates that the respective “specialists” address only the claims directed to their individual specialties. Accordingly, there is no evidence of record supporting the Examiner’s suggestion that a primary examiner from a different art unit would review or approve a qualification or decision of another assigned patent examiner.

If variation of this interpretation is attempted (though the Examiner has not so proposed and such an interpretation would be a new basis for rejection), it would equally fail to suggest the claim limitation. If the *second expert* was the primary examiner, who was selected by a group director or supervisor, this selected *second expert* (primary examiner) would not have an expert qualification which is higher than the *first expert*, as required by the claim limitation.

#### Third Interpretation of MPEP Section 705.01(e)

According to a third interpretation:

a group director can transfer an examiner to a different art unit for a better “fit”, his personal record is sent to a supervisor of said different art unit for reviews

[Office Action, page 3 (citing MPEP Section 705.01(e))].

Contrary to the Examiner’s assertion, Appellants have reviewed MPEP Section 705.01(e) and have found no indication of a process in which a group director transfers a patent examiner, in which a supervisor is *selected* by a group director to receive a “personal record” of an examiner the group director wants to transfer, or in which such a supervisor reviews a “personal record.” There is no support whatsoever in MPEP Section 705.01(e) for this asserted transfer process. Accordingly, there is no substantial evidence that this process was known in the

prior art, and the Examiner's assertion cannot form the basis for any rejection of Claim 177.

### No Substantial Evidence

As discussed above, MPEP Section 705.01(e) is not substantial evidence that could support the Examiner's assertion that the prior art teaches *selecting a second expert that has a second expert qualification which is higher than the first expert qualification (of a first expert for which a first expert qualification was received)*.

Understanding the Examiner may have made an inadvertent error in designating which evidence of record supports the rejection, Appellants have also reviewed the entirety of those pages of the Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9). Nothing in any of the pages teaches, explicitly or implicitly, any of the three practices that the Examiner asserts were known in the prior art.

The Examiner, however, includes a conclusory statement that all of the features of Claim 177 are somehow "inherently taught" in the Manual of Patent Examining Procedure, pp. 700-5 – 700-8 and page 1000-9. [Office Action, page 4]. Appellants believe this statement is an admission by the Examiner that the cited portions do not expressly disclose the above claimed subject matter.

Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Thus, inherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art.

Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597,

1599 (Fed. Cir. 2002). Inherency requires that extrinsic evidence makes it clear that the missing descriptive matter is necessarily present in the reference, and that it would be so recognized by persons of ordinary skill. In re Robertson, 169 F.3d 743 (Fed. Cir. 1999).

Thus, the question raised by the Examiner is whether one skilled in the art would read the discussion of the cited sections as necessarily, not probably or possibly, showing a process that included every step claimed in Claim 177. Applicants cannot identify any evidence in the record to support a finding that one skilled in the art would so read the cited MPEP sections. Specifically, the Examiner does not provide any evidence or explanation to establish that the described Limitations on Use of a Patentability Report (MPEP Section 705.01(e)) or described Exceptions to Partial Signatory Authority (MPEP Section 1005) necessarily involves a specific process that includes every step of the claimed method.

Accordingly, Appellants respectfully submit that *selecting a second expert that has a second expert qualification which is higher than the first expert qualification (of a first expert for which a first expert qualification was received)* is not inherently or explicitly anticipated by the cited MPEP sections. In fact, nothing in the cited evidence would suggest that, after a first expert qualification is received, a second expert (with a higher qualification) is selected. The Examiner has accordingly failed to establish by substantial evidence that the specific method of Claim 177 was known in the prior art, and has not established an unrebuttable *prima facie* case of anticipation.

Appellants also note that the Examiner has included in the Office Action record assertions that were submitted for previous rejections of Claims 177-189. [Office Action, section 7, pp. 7-8 (repeating statements made in the Office Action mailed December 18, 2002, pp. 1-2)]. Appellants find the inclusion of this section

of statements in the Office Action confusing insofar as (1) the Examiner does not link any particular assertion to any specific claim or claimed subject matter; (2) the Examiner does not link any particular assertion to any cited evidence, so the Examiner's reliance on the repeated assertions is unclear; and (3) the Examiner asserts that the previous grounds of rejection are moot (p. 3). Appellants request that in the Examiner's Answer the Examiner clarify the specific assertions that are being relied upon in the present rejections of each claim and the evidence in support of each, rather than having a section of arguments and separate section repeating assertions that are without any evidentiary basis and have already been disputed.

**3.4. No showing that MPEP Section 1005 teaches *transmitting the first expert qualification to the (selected) second expert***

The Examiner has not shown that the references, alone or in combination, suggest *transmitting the first expert qualification to the (selected) second expert*. With respect to this claimed subject matter the Examiner puts forth at least two interpretations of what was allegedly known in the prior art. The only evidence cited in support of all of the interpretations is MPEP Section 1005. In fact, nothing in the cited evidence would suggest transmitting an expert qualification to a second expert after the second expert is selected. Accordingly, the Examiner has not provided a *prima facie* case of unpatentability of this claim.

**First Interpretation of MPEP Section 1005**

The Examiner asserts:

internal "transmitting" via computer communication said examiner's qualification to that group director/supervisor for a best match between examiners to examining a customer's application

[Office Action, page 3 (citing MPEP Section 1005)].

Appellants understand that in this first interpretation, the *first expert* of the claim limitation is a patent examiner to whom a patent application might be assigned, and the *second expert* of the claim limitation is a group director or supervisor. Appellants have reviewed MPEP Section 1005 and have found no indication of a process in which an expert qualification is transmitted to any party, much less a “computer communication” of an “examiner’s qualification,” much less “for a best match between examiner’s to examining a customer’s application.” The Examiner does not even explain how any description in MPEP Section 1005 could be interpreted as suggesting an *expert qualification; transmitting an expert qualification* of one expert to another having a higher qualification; selecting a second expert, group director, or supervisor; or from whom a group director or supervisor would receive an expert qualification.

In particular, MPEP Section 1005 includes only a list of Exceptions to Partial Signatory Authority. There is no discussion of transmitting expert qualifications, much less transmitting an expert qualification of one expert to a second (selected and having a higher qualification) expert. Nothing in MPEP Section 1005 hints at finding a “best match between examiners.” Accordingly, MPEP Section 1005 is not even substantial evidence that the asserted subject matter was known in the prior art, much less that the specific claimed subject matter was known.

#### Second Interpretation of MPEP Section 1005

According to a second interpretation:

this section inherently requires an examiner having Partial-Signatory-Authority to sign a certain Office Action after he has been authorized to do so (after examiner’s qualification is reviewed by a group director)

[Office Action, pages 3-4 (citing MPEP Section 1005].

Appellants' understand the Examiner is asserting that it was known to have a group director review an examiner's qualification and authorize an examiner to have Partial Signatory Authority. MPEP Section 1005 is not substantial evidence of such a process. In particular, Appellants have reviewed MPEP Section 1005 and there is no hint as to how an examiner is "delegated partial signatory authority."

The Examiner argues that the asserted process is somehow "inherent" in MPEP Section 1005, but the Examiner provides no explanation as to why any description in MPEP Section 1005 necessarily, not probably, would require the asserted process. All MPEP Section 1005 indicates is that partial signatory authority is somehow delegated; it does not hint at how or by whom. There is no indication that such delegation is necessarily based on expert qualification, much less that such delegation would necessarily require transmitting an expert qualification of one expert to another expert having a higher expert qualification for any purpose.

#### No Substantial Evidence

As discussed above, MPEP Section 1005 is not substantial evidence that could support the Examiner's assertion that the prior art teaches *transmitting the first expert qualification to the (selected) second expert*.

Understanding the Examiner may have made an inadvertent error in designating which evidence of record supports the rejection, Appellants have also reviewed the entirety of those pages of the Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9). Nothing in any of the pages teaches, explicitly or implicitly, any of the three practices that the Examiner asserts were known in the prior art.

As noted above, however, the Office Action includes a conclusory statement that all of the features of Claim 177 are somehow “inherently taught” in the Manual of Patent Examining Procedure, pp. 700-5 – 700-8 and page 1000-9. [Office Action, page 4]. Applicants cannot identify any evidence in the record to support a finding that one skilled in the art would read any of the cited MPEP sections as inherently teaching *transmitting the first expert qualification to the (selected) second expert*. Specifically, the Examiner does not provide any evidence or explanation to establish that the described Limitations on Use of a Patentability Report (MPEP Section 705.01(e)) or described Exceptions to Partial Signatory Authority (MPEP Section 1005) necessarily involves a specific process that includes *transmitting the first expert qualification to the (selected) second expert*.

Accordingly, Appellants respectfully submit that *transmitting the first expert qualification to the (selected) second expert* is not inherently or explicitly anticipated by the cited MPEP sections. In fact, nothing in the cited evidence would suggest *transmitting a first expert qualification corresponding to a first expert, to a second expert (having a higher expert qualification) after selecting the second expert*. The Examiner has accordingly failed to establish by substantial evidence that the specific method of Claim 177 was known in the prior art, and has not established an unrefuttable *prima facie* case of anticipation.

### **3.5. No showing that MPEP Section 1005 teaches receiving a signal from the second expert that indicates approval of the first expert qualification**

The Examiner has not shown that the references, alone or in combination, suggest *receiving a signal from the second expert that indicates approval of the first expert qualification*. With respect to this claimed subject matter the Examiner puts forth at least two interpretations of what was allegedly known in the prior art.

The only evidence cited in support of all of the interpretations is MPEP Section 1005. In fact, nothing in the cited evidence would suggest receiving a signal from a second expert (having a higher expert qualification) that indicates approval of a first expert qualification of a first expert. Accordingly, the Examiner has not provided a *prima facie* case of unpatentability of this claim.

#### First Interpretation of MPEP Section 1005

The Examiner asserts:

i.e., a supervisor “assigns” a specific patent application to said examiner after reviewing and approval of said examiner’s qualification for a claimed specific subject matter

[Office Action, page 4 (citing MPEP Section 1005)].

Appellants understand that in this first interpretation, the *first expert* of the claim limitation is a patent examiner to whom a patent application might be assigned, and the *second expert* of the claim limitation is a supervisor.

Appellants have reviewed MPEP Section 1005 (and also MPEP Section 705.01(e)) and have found no description of a process in which a group director or supervisor assigns a particular patent application to a particular patent examiner, much less reviews an examiner’s qualification or approves of such a qualification “for a claimed specific subject matter.”

Nonetheless, according to this finding of the Examiner, the *second expert* selects a *first expert*. This situation is in fact typical of many hierarchical relationships, where those with higher skills manage and select among their subordinates with lower skills. However, it is clearly the opposite of the claim limitation in which the *second expert* (with a higher expert qualification) is selected. The Examiner’s example has the *first expert* being selected by the *second expert*. It would be nonsensical to argue that the second expert (“group director”) somehow selects himself.

Further, in this interpretation, there is no indication that this *expert qualification* of the examiner is *transmitted* to the supervisor, and no indication that any sort of *signal is received from* the supervisor which *indicates approval of the transmitted expert qualification* of the examiner, or by whom such a signal would be received. There is no indicated need for a supervisor to "approve" (or disapprove) of the expert qualifications of any examiner.

Appellants note that MPEP Section 1005 includes only a list of Exceptions to Partial Signatory Authority. There is no discussion of assigning applications, much less a supervisor transmitting a signal that indicates approval of an expert qualification of a particular patent examiner. Nothing in MPEP Section 1005 hints at such assigning. Accordingly, MPEP Section 1005 is not even substantial evidence that the asserted subject matter was known in the prior art, much less that the specific claimed subject matter was known.

#### Second Interpretation of MPEP Section 1005

According to a second interpretation:  
a group director gives "Partial-Signatory-Authority" to an examiner  
[Office Action, page 4 (citing MPEP Section 1005].

Appellants' understand the Examiner is again asserting (as discussed above with respect to the step of *transmitting*) that it was known to have a group director review an examiner's qualification and authorize an examiner to have Partial Signatory Authority. MPEP Section 1005 is not substantial evidence of such a process. In particular, Appellants have reviewed MPEP Section 1005 and there is no hint as to how an examiner is "delegated partial signatory authority." The Examiner provides no explanation as to why any description in MPEP Section 1005 necessarily, not probably, would require the asserted process. All MPEP Section 1005 indicates is that partial signatory authority is somehow delegated; it

does not hint at how or by whom. There is no indication that such delegation is necessarily based on expert qualification, much less that such delegation would necessarily require transmitting an expert qualification of one expert to another expert having a higher expert qualification for any purpose, much less that a group director would transmit a signal indicating approval of an expert qualification of a patent examiner for any purpose.

No Substantial Evidence

As discussed above, MPEP Section 1005 is not substantial evidence that could support the Examiner's assertion that the prior art teaches *receiving a signal from the second expert that indicates approval of the first expert qualification*.

Understanding the Examiner may have made an inadvertent error in designating which evidence of record supports the rejection, Appellants have also reviewed the entirety of those pages of the Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9). Nothing in any of the pages teaches, explicitly or implicitly, any of the practices that the Examiner asserts were known in the prior art.

As noted above, however, the Office Action includes a conclusory statement that all of the features of Claim 177 are somehow “inherently taught” in the Manual of Patent Examining Procedure, pp. 700-5 – 700-8 and page 1000-9. [Office Action, page 4]. Applicants cannot identify any evidence in the record to support a finding that one skilled in the art would read any of the cited MPEP sections as inherently teaching *receiving a signal from the second expert that indicates approval of the first expert qualification*. Specifically, the Examiner does not provide any evidence or explanation to establish that the described Limitations on Use of a Patentability Report (MPEP Section 705.01(e)) or described Exceptions to Partial Signatory Authority (MPEP Section 1005) necessarily

involves a specific process that includes *receiving a signal from the second expert that indicates approval of the first expert qualification*.

Accordingly, Appellants respectfully submit that *receiving a signal from the second expert that indicates approval of the first expert qualification* is not inherently or explicitly anticipated by the cited MPEP sections. In fact, nothing in the cited evidence would suggest *receiving a signal from the second expert that indicates approval of the first expert qualification*. The Examiner has accordingly failed to establish by substantial evidence that the specific method of Claim 177 was known in the prior art, and has not established an unrebuttable *prima facie* case of anticipation.

### **3.6. Conclusion**

To the extent that the Examiner is relying solely upon MPEP Section 705.01(e) and MPEP Section 1005 as teaching that the particular combination of claimed subject matter of Claim 177 was known to one of ordinary skill in the art, the Section 102(b) rejection cannot stand. At best, the Examiner has made assertions about distinct practices in the USPTO (e.g., assigning applications to examiners, Patentability Reports, authorizing partial signatory authority), without any evidence or articulated reasoning that such different practices would have been recognized as being part of the same process in the prior art. Accordingly, the Examiner has not established that the specific method of Claim 177 was known in the prior art. Further, the Examiner has failed to indicate substantial evidence in support of the Examiner's assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for Claim 177. Appellants request reversal of the Section 102(b) rejection of Claim 177.

**4. Section 103(a)—MPEP Section 705.01(e), Section 1005, and Section 1002.02**

Appealed Claim 178 stands rejected under 35 U.S.C. § 103(a) as being obvious in light of MPEP Section 705.01(e), Section 1005, and Section 1002.02.

**4.1. Introduction**

Claim 178 is independent, but includes all of the steps of independent method Claim 177, discussed in Section 3. Accordingly, all of the arguments presented above with respect to Claim 177 are equally applicable to Claim 178, are incorporated in this argument for Claim 178, and Claim 178 is patentable for at least the same reasons given above for Claim 177. Additional arguments are provided in this section for the patentability of Claim 178, regardless of the patentability of Claim 177.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Claim 178 is flawed because the Examiner has not made a *prima facie* case of obviousness. The Examiner has failed to provide substantial evidence that all of the limitations of Claim 178 were known in the prior art. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications. Further, Claim 178 cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way that renders Claim 178 obvious.

In particular, the Examiner has failed to establish by substantial evidence that *incorporating identity data of the second expert into a key of the first expert* was known in the prior art. The Examiner has also failed to provide substantial evidence that such a feature would have been desirable and an obvious modification to any subject matter in evidence. The Examiner has otherwise failed to provide substantial evidence that the particular claimed subject matter of Claim 178 would have been obvious at the time of Appellants' invention.

In addition to the advantages discussed above in Section 3.1 with respect to Claim 177, the embodiment of Claim 178 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

By *incorporating identity data of the second expert into a key of the first expert*, the first expert may demonstrate approval by one or more higher-level experts, and may also demonstrate the identity of each such higher-level expert. Such a key may be, e.g., provided with the answers that the expert creates. Accordingly, such a key could provide customers of the expert with assurances that the expert was approved.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

## **4.2. Applicable Law**

### **4.2.1. Prima facie burden**

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If examination at the initial stage does not produce a prima facie case of unpatentability, then

without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992).

**4.2.2. Claim interpretation must be consistent with the specification**

During examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2D 1023, 1027 (Fed. Cir. 1997).

**4.2.3. Substantial evidence required for all factual findings**

The Board is not permitted to accept conclusory, unsupported findings made by the Primary Examiner that are not supported by substantial evidence made of record.

All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. *In re Gartside*, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described “substantial evidence” in the following manner:

substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); see also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 1935, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (“Zurko III”).

“[R]eview under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency’s decision.” Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162.

#### **4.2.4. Obviousness**

The examiner bears the initial burden of establishing a prima facie case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2D 1780, 1783 (Fed. Cir. 1992); Oetiker, 977 F.2d at 1445. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. Oetiker, 977 F.2d at 1445.

To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1355, 47 U.S.P.Q.2D 1453, 1455 (Fed. Cir. 1998). The prima facie case is a procedural tool, and requires that the examiner initially produce evidence sufficient to support a ruling of obviousness; thereafter the burden shifts to the applicant to come forward with evidence or argument in rebuttal. In re Kumar, 418 F.3d 1361, 1366, 76 U.S.P.Q.2D 1048, 1050 (Fed. Cir. 2005). The patent applicant may attack the Examiner’s prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness. Fritch, 972 F.2d at 1265. When rebuttal evidence is provided, the prima facie case dissolves, and the decision is made on the entirety of the evidence. Kumar, 418 F.3d at 1366; Oetiker, 977 F.2d at 1445.

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. In Iron Grip Barbell Co. v. USA Sports Inc., the Federal Circuit explained how obviousness must be determined using the four-part Graham test:

we employ the four-part test set forth in Graham v. John Deere Co., 383 U.S. 1 (1966). This test requires us to examine

- (1) the scope and content of the prior art;
- (2) the level of ordinary skill in the art;
- (3) the differences between the claimed invention and the prior art; and
- (4) the objective evidence of nonobviousness. *Id.* at 17-18; see also 35 U.S.C. § 103 (2000).

392 F.3d 1317, 1320, 73 U.S.P.Q.2D (BNA) 1225 (Fed Cir. 2004); see also, Rouffet, 149 F.3d at 1355. U.S. Patent and Trademark Office policy is also to follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 “35 U.S.C. 103; the Graham Factual Inquiries”, p. 2100-120, 8<sup>th</sup> ed., Rev. 2 (May 2004). Accordingly, during examination an examiner must conduct the four factual inquiries enunciated in Graham in determining obviousness of any claim.

The underlying factual determinations on which a conclusion of obviousness is allegedly based are reviewed to ascertain whether they are supported by substantial evidence. In re Kumar, 418 F.3d at 1365 (citing Gartside, 203 F.3d at 1316). Unsupported assessments of the prior art are unacceptable for purposes of review. “Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise.” In re Zurko, 258 F.3d at 1385-86. “[D]eficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common

sense,” nor may the Board simply reach conclusions based on its own understanding or experience. In re Zurko, 258 F.3d at 1385; Lee, 277 F.3d at 1344. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” Lee, 277 F.3d at 1344.

A determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666, 57 U.S.P.Q.2D 1161, 1168 (Fed. Cir. 2000) (citing Custom Accessories Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962, 1 U.S.P.Q.2D 1196, 1201 (Fed. Cir. 1986)). Ascertaining a level of ordinary skill in the art is necessary. M.P.E.P. § 2141.03.

In making the assessment of differences between the prior art and the claimed subject matter, Section 103 specifically requires consideration of the claimed invention “as a whole.” Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 75, U.S.P.Q.2D 1051, 1054 (Fed. Cir. 2005); Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275, 69 U.S.P.Q.2D 1686, 1690 (Fed. Cir. 2004). Inventions typically are new combinations of existing principles or features. Env'l. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part and requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. Ruiz, 357 F.3d at 1275.

Whether a rejection is based on a purported combination of relevant teachings of separate references, or on a purported modification of the prior art, an examiner can satisfy the *prima facie* burden only by showing some objective

teaching (either in the prior art or the knowledge generally available to one of ordinary skill) would lead to the purported combination or modification. Fritch, 972 F.2d at 1265-66; Rouffet, 149 F.3d at 1355-56. Also, where the examiner fails to explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the claimed invention to make an alleged combination of references, the court may infer that the examiner selected the references with the assistance of hindsight, which is forbidden. Lacking a motivation to combine, there is no *prima facie* case of obviousness. Rouffet, 149 F.3d at 1358. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. Oetiker, 977 F.2d at 1447.

“Recognition of an unsolved problem does not render the solution obvious.” Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 381 F.3d 1371, 1377, 72 U.S.P.Q.2D 1333, 1337 (Fed. Cir. 2004) (“Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure.”).

A “teaching or suggestion or motivation [to combine]” is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2D 1225, 1232 (Fed. Cir. 1998). Evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D 1614, 1617 (Fed. Cir. 1999); see also, e.g., Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd., 357 F.3d 1319, 1337-39, 69 U.S.P.Q.2D

1641, 1655-56 (Fed. Cir. 2004) (finding that whether or not a drawing and disclosure had been disseminated to a sufficiently broad public so as to give either the status of a prior art reference, they (and corresponding witness testimony) were evidence relevant to whether a motivation to combine was implicit in the knowledge of one of ordinary skill in the relevant art).

“The range of sources available, however, does not diminish the requirement for actual evidence” showing the teaching or motivation to combine—“particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references” must be made. Dembiczak, 175 F.3d at 999-1000 (“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.”). See also, In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D 1313, 1317 (Fed. Cir. 2000) (“Whether the Board relies on an express or an implicit showing [of a teaching, motivation, or suggestion to combine or modify], it must provide particular findings related thereto.”)

Any findings of prior knowledge in the field of the invention (including purported motivations to combine) must be supported by tangible teachings of materials made of record. Cardiac Pacemakers, 381 F.3d at 1376 (“Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials “); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578-79, 42 U.S.P.Q.2D 1378, 1383 (Fed. Cir. 1997) (“However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

#### **4.3. No Prima Facie Showing of Unpatentability of Claim 178**

A reading of the rejection of Claim 178 reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of Claim 178.

##### **4.3.1. No showing that the references suggest incorporating identity data of the second expert into a key of the first expert**

The Examiner has not shown that the prior art teaches *incorporating identity data of the second expert into a key of the first expert*. The only evidence cited in support of this assertion is MPEP Section 1002.02. In fact, nothing in the cited evidence would suggest a key of a first expert, much less incorporating identity data of a selected second expert (having a higher qualification) into a key of a first expert. Accordingly, the Examiner has not provided a prima facie case of unpatentability of this claim.

The Examiner asserts:

i.e., the names of a group director/supervisor and his examiners have been required to put together as alternative points-of-contact in a USPTO Office Action (see USPTO's MPEP Rev. 13, Nov. 1989, chapter 1002.02, page 1000-3 for teaching that identity data (names, art unit, Technology Center) of a group director and his examiner appears on an Official Document at USPTO; if a consultation about a specific topic was happened, said primary examiner's name has been included in the record for search consultation).

[Office Action, pages 4-5].

Appellants understand that according to this interpretation, a patent examiner is a *first expert*; a group director, supervisor, or primary examiner is a *second expert*; and an Office Action or Official Document is *a key of the first expert*.

Appellants first note that MPEP Section 1002.02 (“Delegation of Authority to Decide Petitions”) has nothing to do with any requirement “teaching that identity data...of a group director and his examiner appears on an Official Document.” In fact, Appellants have reviewed all of MPEP Section 1002.02(a)-(p) and are unable to find any description that states that any type of document must include identity data of a group director, a supervisor, or a primary examiner and an examiner.

Regardless, the Examiner has not even attempted to explain how any portion of MPEP Section 1002.02 would have been interpreted by one having ordinary skill in the art as *a key of the first expert*. There is nothing in the cited references that would suggest any Office Action or other document of the USPTO would suggest *a key of a first expert*. Appellants request that the Examiner clarify in the Examiner’s Answer how that claimed feature is being interpreted (consistently with the Specification, as required), and how any cited evidence teaches or suggests that interpretation. Appellants submit that neither the asserted “Office Action” nor “Official Document” teaches or suggests such a feature. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

Appellants are not clear as to the reference to a “consultation about a specific topic” or “the record for search consultation.” It is possible that the Examiner is referring to the rejection of Claim 177, in which the Examiner asserted that it was known to consult with a primary examiner about a specific subject matter. That argument was disputed above with respect to Claim 177, at least because the cited MPEP Section 705.01(e) could not support it, and also because even if there was evidence such a practice was known, the primary examiner (the asserted *second expert*) in that scenario does not review or approve the qualification of any other examiner (the asserted *first expert*). Neither MPEP

Section 705.01(e) nor MPEP Section 1002.02 cannot support any such interpretation of the prior art, and do not include any hint or suggestion of “the record for search consultation” referred to by the Examiner. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason. Appellants request that the Examiner clarify in the Examiner’s Answer what evidence is being relied upon as teaching or suggesting the asserted “consultation” and “the record for search consultation” practice.

#### **4.4. Claim 178 is Allowable Over the Cited References**

As described above, the Examiner has failed to provide a *prima facie* showing of obviousness. In addition, the references cannot be combined in any manner that would render Claim 178 obvious.

No cited reference suggests *incorporating identity data of the second expert into a key of the first expert*. No reference has anything to do with incorporating identity data of an expert in any way, much less in a key, much less in a key of another [lower level] expert.

#### **4.5. Conclusion**

To the extent that the Examiner is relying solely upon MPEP Section 705.01(e), MPEP Section 1005, and MPEP Section 1002.02 as evidence that the particular combination of claimed subject matter of Claim 178 was obvious to one of ordinary skill in the art, the Section 103(a) rejection cannot stand. None of the references (alone or in combination) disclose or suggest the limitations of the claim 178, and none of the references (alone or in combination) possess the advantages conferred by those limitations. At best, the Examiner has made unsupported assertions about distinct practices in the USPTO (e.g., assigning applications to examiners, Patentability Reports, consulting with primary examiners, authorizing

partial signatory authority), without any evidence or articulated reasoning that such different practices would have been recognized as desirable as part of the same process. Accordingly, the Examiner has not established that the specific method of Claim 178 was obvious in light of the cited references. Further, the Examiner has failed to indicate substantial evidence in support of the Examiner's assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for Claim 178. Appellants request reversal of the Section 103(a) rejection of Claim 178.

**5. Section 103(a)—MPEP Section 705.01(e), Section 1005, Section 1002.02 and Unsupported Assertions**

Appealed Claims 178-189 stand rejected under 35 U.S.C. § 103(a) as being obvious in light of MPEP Section 705.01(e), Section 1005, Section 1002.02, and asserted subject matter that the Examiner does not even indicate any evidence of record could support.

The Examiner's Section 103(a) rejections based on the above grounds are argued separately for different claims. The claims do not stand and fall together. Each of the separate arguments is addressed below under a separate heading.

**5.1. Claims 179 – 184**

Claim 179 is independent. Claims 180-184 depend from Claim 179. Accordingly, the arguments provided in this section with respect to Claim 179 are equally applicable to Claims 180-184.

As discussed below, the rejection of Claim 179 is flawed because the Examiner has not made a *prima facie* case of unpatentability of Claim 179. The Examiner has not shown all limitations of Claim 179 to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, Claim 179 cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders Claim 179 obvious.

The Examiner's rejection of Claim 179 fails the minimal threshold of clarity required by 35 U.S.C. § 132. Although the rejection purports to be under Section 103(a), the Examiner only refers generally to MPEP Revision 14 (only selected pages of which are evidence of record), does not indicate any claimed subject matter that is not taught or suggested by any particular reference, does not indicate that there is a need to modify or combine any particular reference(s), and does not indicate any motivation to provide for all of the features of Claim 179.

Accordingly, it is fatally unclear whether the Examiner is providing an anticipation rejection (and if so, under what paragraph of Section 102 and on what evidentiary basis) or an obviousness rejection (and if so, on what evidentiary basis).

The embodiment of Claim 179 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages render the claimed subject matter nonobvious over the cited art.

*By submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification, and also by receiving a signal from the set of experts that indicates approval of the first expert qualification, the expert who is to provide an expert answer may be reviewed. Thus, the expert's answer is more trusted by the end user. Accordingly, customers of the expert have assurances about the expert.*

*By transmitting at least a portion of the end user request to the first expert, and receiving an expert answer responsive to the end user request, the end user's request can be answered by an expert. This can be useful, e.g., in a system in which experts sell their advice, possibly anonymously.*

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

**5.1.1. No Prima Facie Showing of Unpatentability of Claim 179**

A reading of the rejection Claim 179 reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of Claim 179.

**5.1.1.1. No Motivation to Combine or Modify the Cited References**

The Examiner does not even articulate a motivation to combine or modify any of the pages of Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9) in a manner that would provide for all of the features of Claim 179, much less articulate any reasoning or evidence to support any motivation. Accordingly, the Examiner cannot have provided a prima facie case of obviousness, and the Section 103(a) rejection of Claim 179 must be reversed.

**5.1.1.2. No showing that the references suggest submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification**

The Examiner has not shown that the references, alone or in combination, suggest *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification*.

The Examiner asserts:

e.g., personal record of an examiner has been distributed to different supervisor(s) for a better match

[Office Action, page 5]. The Examiner does not cite any particular section of the MPEP documents placed in the record. Appellants have reviewed the entirety of

those pages of the Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9). There is no hint in the cited documents of a process for a “better match” or distributing personal records to supervisors. The Examiner has failed even to provide evidence that the asserted practice was known. Further, nothing in any of the references suggests *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification.*

Accordingly, there is no substantial evidence that such a feature was known. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

The Examiner has not shown that the references, alone or in combination, teach an alleged prior art practice, or suggest *submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification.* Further, the cited references do not teach or suggest such a feature.

**5.1.1.3. No showing that the references suggest receiving a signal from the set of experts that indicates approval of the first expert qualification**

The Examiner has not shown that the references, alone or in combination, suggest *receiving a signal from the set of experts that indicates approval of the first expert qualification.*

With respect to this feature, the Examiner asserts:

e.g., a telephone call from a supervisor to a director

[Office Action, page 4]. The Examiner does not cite any particular section of the MPEP documents placed in the record. Appellants have reviewed the entirety of those pages of the Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9). There is no

hint in the cited documents of a telephone call from a supervisor to a director. The Examiner has failed even to provide evidence that the asserted practice was known. Further, nothing in any of the references suggests *receiving a signal from the set of experts that indicates approval of the first expert qualification*. Accordingly, there is no substantial evidence that the claimed feature was known. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

The Examiner has not shown that the references, alone or in combination, teach an alleged prior art practice, or suggest *receiving a signal from the set of experts that indicates approval of the first expert qualification*. Further, the cited references do not teach or suggest such a feature.

#### **5.1.2. Conclusion**

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of Claims 179-184, none of the references (alone or in combination) disclose or suggest the limitations of Claims 179-184, and none of the references (alone or in combination) possess the advantages conferred by those limitations. Accordingly, for at least those reasons, Claims 179-184 are patentable in view of the cited references.

## **5.2. Claims 185-189**

Claim 185 is independent. Claims 186-189 depend from Claim 185. Accordingly, the arguments included in this section with respect to Claim 185 are equally applicable to Claims 186-189.

Independent Claim 185 includes all of the limitations of independent claim 177, discussed above in Section 3. Accordingly, all of the arguments presented above with respect to Claim 177 are equally applicable to Claim 185, are incorporated in this argument for Claim 185, and Claim 185 is patentable for at least the same reasons given above for Claim 177. Additional arguments are provided in this section for the patentability of Claim 185, regardless of the patentability of Claim 177.

As discussed below, the rejection of Claim 185 is flawed because the Examiner has not made a *prima facie* case of unpatentability of Claim 185. The Examiner has not shown all limitations of Claim 185 to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, Claim 185 cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way that renders Claim 185 obvious.

The Examiner's rejection of Claim 185 fails the minimal threshold of clarity required by 35 U.S.C. § 132. Although the rejection purports to be under Section 103(a), the Examiner only refers generally to MPEP Revision 14 (only selected

pages of which are evidence of record), does not indicate any claimed subject matter that is not taught or suggested by any particular reference, does not indicate that there is a need to modify or combine any particular reference(s), and does not indicate any motivation to provide for all of the features of Claim 185. Also, in paragraph 6(D) of the Office Action, the Examiner simply recites Claim 185, without any analysis or findings at all. Accordingly, it is fatally unclear whether the Examiner is providing an anticipation rejection (and if so, under what paragraph of Section 102 and on what evidentiary basis) or an obviousness rejection (and if so, on what evidentiary basis).

The embodiment of Claim 185 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages render the claimed subject matter nonobvious over the cited art.

In addition to the advantages discussed above with respect to Claim 177, the embodiment of Claim 185 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

By *selecting the first expert based on a received end user request*, it may be assured that only appropriate experts for the particular request are selected.

By *transmitting at least a portion of the end user request to the first expert, and receiving an expert answer responsive to the end user request*, the end user's request can be answered by an expert. This can be useful, e.g., in a system in which experts sell their advice, possibly anonymously.

Because *the expert answer contains information about the second [higher-level] expert*, the first expert may demonstrate approval by one or more higher-level experts, and may also demonstrate the identity of each such higher-level

expert. By implication, the expert's answer is more trusted by the end user. Accordingly, customers of the expert have assurances about the expert.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

**5.2.1. No Prima Facie Showing of Unpatentability of Claim 185**

A reading of the rejection Claim 185 reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of Claim 185.

**5.2.1.1. No Motivation to Combine or Modify the Cited References**

The Examiner does not even articulate a motivation to combine or modify any of the pages of Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9) in a manner that would provide for all of the features of Claim 185, much less articulate any reasoning or evidence to support any motivation. Accordingly, the Examiner cannot have provided a prima facie case of obviousness, and the Section 103(a) rejection of Claim 185 must be reversed.

**5.2.1.2. No showing that the references suggest selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification and transmitting the first expert qualification to the second expert**

The Examiner has not shown that the references, alone or in combination, suggest *selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification and transmitting the first expert qualification to the second expert.*

The Examiner asserts:

e.g., personal record of an examiner has been distributed to different supervisor(s) for a better match

[Office Action, page 5]. The Examiner does not cite any particular section of the MPEP documents placed in the record. Appellants have reviewed the entirety of those pages of the Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9). There is no hint in the cited documents of a process for a “better match” or distributing personal records to supervisors. The Examiner has failed even to provide evidence that the asserted practice was known. Further, nothing in any of the references suggests *selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification and transmitting the first expert qualification to the second expert.* Accordingly, there is no substantial evidence that such a feature was known. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

The Examiner has not shown that the references, alone or in combination, teach an alleged prior art practice, or suggest *selecting a second expert that has a second expert qualification, the second expert qualification being higher than the*

*first expert qualification and transmitting the first expert qualification to the second expert.* Further, the cited references do not teach or suggest such a feature.

**5.2.1.3. No showing that the references suggest receiving a signal from the second expert that indicates approval of the first expert qualification**

The Examiner has not shown that the references, alone or in combination, suggest *receiving a signal from the second expert that indicates approval of the first expert qualification.*

With respect to this feature, the Examiner asserts:

e.g., a telephone call from a supervisor to a director

[Office Action, page 4]. The Examiner does not cite any particular section of the MPEP documents placed in the record. Appellants have reviewed the entirety of those pages of the Manual of Patent Examining Procedure that have been made of record in this application (pp. 700-5 – 700-8, and 1000-1 – 1000-9). There is no hint in the cited documents of a telephone call from a supervisor to a director. The Examiner has failed even to provide evidence that the asserted practice was known. Further, nothing in any of the references suggests *receiving a signal from the second expert that indicates approval of the first expert qualification.*

Accordingly, there is no substantial evidence that the claimed feature was known. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

The Examiner has not shown that the references, alone or in combination, teach an alleged prior art practice, or suggest *receiving a signal from the second expert that indicates approval of the first expert qualification.* Further, the cited references do not teach or suggest such a feature.

**5.2.2. Conclusion**

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of Claims 185-189, none of the references (alone or in combination) disclose or suggest the limitations of any of Claims 185-189, and none of the references (alone or in combination) possess the advantages conferred by those limitations. Accordingly, for at least those reasons, Claims 185-189 are patentable in view of the cited references.

## **CONCLUSION**

Thus, the Examiner's rejection of the pending claims is improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Appellants' representative using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

November 20, 2006

Date

/Michael Downs/

Michael Downs  
Attorney for Appellants  
Registration No. 50, 252  
Walker Digital, LLC  
mdowns@walkerdigital.com  
(203) 461-7292 /voice  
(203) 461-7300 /fax

## **APPENDIX A—CLAIMS INVOLVED IN THE APPEAL**

Claims 177-189 are being appealed.

Appealed Claims 177, 178, 179, and 185 are independent.

177. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

receiving a first expert qualification corresponding to a first expert;

selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;

transmitting the first expert qualification to the second expert; and

receiving a signal from the second expert that indicates approval of the first expert qualification.

178. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

receiving a first expert qualification corresponding to a first expert;

selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;

transmitting the first expert qualification to the second expert;

receiving a signal from the second expert that indicates approval of the first expert qualification; and

incorporating identity data of the second expert into a key of the first expert.

179. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:
- receiving a first expert qualification corresponding to a first expert;
  - submitting the first expert qualification for review by a set of experts that each have a qualification that is higher than the first expert qualification;
  - receiving a signal from the set of experts that indicates approval of the first expert qualification;
  - receiving an end user request from an end user;
  - selecting the first expert based on the end user request;
  - transmitting at least a portion of the end user request to the first expert;
  - receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert; and
  - transmitting the expert answer to the end user.

180. The method of claim 179, further comprising:  
guaranteeing payment to the first expert.

181. The method of claim 180, wherein said guaranteeing payment to the first expert comprises:  
requiring the end user to prepay.

182. The method of claim 180, wherein said guaranteeing payment to the first expert comprises:  
checking a credit card account.

183. The method of claim 182, wherein said checking a credit card account is performed before said transmitting at least a portion of the end user request to the first expert.

184. The method of claim 182, further comprising:  
establishing a price for the expert answer corresponding to the end user request; and

if credit available on the credit card account is less than the price of the expert answer, requesting that the end user provide a credit card number of another credit card account.

185. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

receiving a first expert qualification corresponding to a first expert;  
selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;  
transmitting the first expert qualification to the second expert;  
receiving a signal from the second expert that indicates approval of the first expert qualification;  
receiving an end user request from an end user;  
selecting the first expert based on the end user request;  
transmitting at least a portion of the end user request to the first expert;  
receiving the expert answer responsive to the end user request; the expert answer containing information about the second expert; and  
transmitting the expert answer to the end user.

186. The method of claim 185, further comprising:  
guaranteeing payment to the first expert.

187. The method of claim 186, wherein said guaranteeing payment  
comprises:

requiring the end user to prepay.

188. The method of claim 186, wherein said guaranteeing payment  
comprises:

checking a credit card account.

189. The method of claim 188, wherein said checking a credit card  
account is performed before said transmitting at least a portion of the end user  
request to the first expert.

**APPENDIX B—EVIDENCE**

<NONE>

**APPENDIX C—RELATED PROCEEDINGS**

<NONE>